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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,072	08/04/2003	Robert Anthony	35580US2	5241
116	7590	10/03/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			LUONG, SHIAN TINH NHAN	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/634,072	Applicant(s) ANTHONY ET AL.	
	Examiner Shian T. Luong	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-28 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2/03</u> . | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 112

1. Claims 1-2, 6-7,13-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the term “a gapped magnetic zone” has no clear meaning. In claim 6, the phrase “extend in a plane above the location of a scalpel” is unclear. Applicant has not claimed the scalpel and hence the shape, size and height of the scalpel cannot be in comparison with the finger guards. Also in claim 7, it is not certain what portions of the finger guards are remote from the area that extends downward from the plane. In claims 8 and 19, the term “wasp waist configuration” has no definite meaning. There is no definite shape to a wasp waist. For claim 10, the specification does not disclose a thin membrane in the throat area. For claim 20, “the magnetic holding area straddling said slot” is so indefinite that it is not possible for the examiner to determine the exact limitation applicant intends to claim. Applicant needs to clarify how the holding area is straddling the slot. In claim 13, the term “the receiving chamber” on line 9 lacks proper antecedent basis. Clarification is required.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a thin membrane in claim 10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Perkins (US 4,303,158). Perkins 1 discloses a multipurpose handling device comprising in combination a system 17 for temporarily holding a tool. A magnetic zone 49, a closable storage container 25,17,19,48, and a suture pack carrier 51.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-9,12,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krafft (US 5,492,671). Krafft discloses a device comprising a body 3 including a supporting base, a receiver 10 adjacent one end of the base, a scalpel handle grip 10 adjacent an end of the base opposite said one end, the receiver being arranged to limit freedom of movement of one part of the tool laterally while allowing pitch movement of another part of the tool, the handle grip being arranged to resist longitudinal reverse movement of the tool out of the receiver. A finger grip area is the rectangular panel on each end. The finger guards are located on opposite sides of an area between the grip and the receiver. The receiver has a narrow throat as shown in Figures 2-6. The restraining portion is any protruding portion in the throat area.

Although the case not made out of thermoplastic body, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the case out of thermoplastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In addition, it would have been obvious to make the handle out of any configuration for ease of handling the carrier.

7. Claims 13,18-19,21,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arp et al. (US 4,643,303). Arp et al. discloses a device comprising a body including a

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supporting base, a receiver 84 adjacent one end of the base, a handle grip 84 adjacent an end of the base opposite said one end, the receiver being arranged to limit freedom of movement of one part of the tool laterally while allowing pitch movement of another part of the tool, the handle grip being arranged to resist longitudinal reverse movement of the tool out of the receiver. A finger grip area is the panel on each side or end. The finger guards are located on opposite sides of an area between the grip and the receiver. The device is closable and has a container portion 56. A chamber is inbetween the receiving zone and remote from the gripping area. The case has a releasable latch 38,40. Any portion of the rear surface is the mounting zone and is opposite to a common surface of the receiving containers.

Although the case not made out of thermoplastic body, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the case out of thermoplastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In addition, it would have been obvious to make the handle out of any configuration for ease of handling the carrier.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arp et al. in view of Official Notice. Although the cover of Arp et al. does not disclose as being hinged, Official Notice is taken of the conventional use of a hinge to secure the cover to a base. It would then be an obvious modification to provide a hinged cover to secure the base and cover together.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krafft in view of Official Notice. Although Krafft does not disclose of a non-slip surface, Official Notice is taken

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of the conventional use of non-slip material to prevent the tray or container from inadvertent movement. It would have been obvious to provide the non-slip surface on a lower surface of the tray to prevent unnecessary movement.

Allowable Subject Matter

10. Claims 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 10 also has to overcome the drawing objection.

11. Claims 15-17,20,23-26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08.


If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Erica Miller at (571) 272-4370.

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For applicant's convenience, the official FAX number is 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (571) 272-4557. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL
September 30, 2005


Primary Examiner
Shian Luong
Art Unit 3728